

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
Mark PETERS et al.	:	Confirmation Number: 6041
	:	
Application No.: 10/675,503	:	Group Art Unit: 3692
	:	
Filed: September 30, 2003	:	Examiner: B. Fields
	:	
For: DYNAMIC PROCESSING OF PAYMENT REQUESTS FOR MOBILE COMMERCE TRANSACTIONS	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated July 7, 2008.

The Examiner's response to Appellants' arguments submitted in the Second Appeal Brief of June 11, 2008 (hereinafter the Second Appeal Brief), raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Second Appeal Brief, and the arguments set forth below.

REMARKS

Appellants have compared the statement of the rejection found on pages 3-7 of the Examiner's Answer with the statement of the rejection found on pages 3-7 of the Third Office Action. Upon making this comparison, Appellants have been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellants proceed on the basis that the Examiner's sole response to Appellants' Second Appeal Brief is found on pages 7-14 of the Examiner's Answer.

On page 4 of the Second Appeal Brief, Appellants pointed out where the Examiner's Answer is required to include particular content discussed in M.P.E.P. § 1207.02. However, as will be subsequently discussed below, the Examiner has not met requirement. As noted throughout the prosecution of this application and in the Second Appeal Brief, the Examiner has failed to properly establish the facts underlying the Examiner's analysis. Appellants' position is that these omissions in the Examiner's prima facie analysis are correctable by the Examiner, and the correction of these omissions would help both Appellants and the Honorable Board gain a better understanding of the underlying facts and analysis employed by the Examiner in rejecting the claims. Thus, Appellants respectfully recommend that the Honorable Board remand the present application to the Examiner to address these omissions.¹

¹ The Board has persistently declined to uphold an Examiner because of omissions in the Examiner's half of the record. *E.g.*, *Ex parte Daleiden*, Appeal 2007-1003 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); *Ex parte Rozzi*, 63 USPQ2d 1196, 1200-03 (BPAI 2002) (remanding without decision because of a host of examiner omissions and procedural errors); *Ex parte Gambogi*, 62 USPQ2d 1209, 1212 (BPAI 2001) ("We decline to tell an examiner precisely how to set out a rejection."); *Ex parte Jones*, 62 USPQ2d 1206, 1208 (BPAI 2001) (refusing to adjudicate an issue that the examiner has not developed); *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI 2000) ("The examiner has left applicant and the board to guess as to the basis of the rejection ... We are not good at guessing; hence, we decline to guess."); *Ex parte Bracken*, 54 USPQ2d 1110, 1112-13 (BPAI 1999) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

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3 Within the Examiner's Answer, the Examiner responded to six separate sets of arguments
4 (numbered 1 through 6) within the Second Appeal Brief. Appellants will separately address each
5 of the Examiner's responses. In responding to arguments found on page 4, line 6 through page 5,
6 line 18 of the Second Appeal Brief, the Examiner asserted the following in the last full paragraph
7 on page 8 of the Examiner's Answer:

8 The Examiner wishes to clarify the matter as to which reference is being relied upon to
9 teach the limitation: "a proxy server disposed in said wireless service provider network". While
10 the third office action does, at Page 3, 'seemingly' show a reliance on Suzuki in order to show the
11 elements of all the claim language within Claim 1, the Examiner relied upon the combination of
12 both Suzuki and Steed to discuss the limitations found in Claim 1. On Page 3 of the third office
13 action it should be noted that the contents which the examiner did not rely upon within Suzuki
14 were placed in brackets: "[a relay server [proxy server] disposed in said wireless service
15 provider network (Suzuki: Figures 2-3; Page 2, Paragraph 0017; Page 3, Paragraph
16 0048//Suzuki discloses a system which possesses a relay server [which operates as a content
17 proxy server//)]". The Examiner the relied upon Steed to show this material on Page 4 of the
18 third office action. (emphasis in original)
19

20 Despite allegedly being to clarify the Examiner's analysis, the above-reproduced statement by the
21 Examiner only serves to further confuse matters. The Examiner states that "the contents which
22 the examiner did not rely upon within Suzuki were placed in brackets," the language to which the
23 Examiner refers (i.e., the **bolded** passage) is entirely within brackets, which implies that Suzuki
24 was not relied upon at all to teach any of these limitations. However, this appears to be contrary
25 to the remainder of the Examiner's analysis.
26

27 Although not entirely clear from the Examiner's analysis, Appellants proceed on the basis
28 that the Examiner is relying upon Suzuki to teach "a relay server disposed in said wireless
29 service provider network," and Steed was intended to teach the proxy server. However, even this
30 is inconsistent with the Examiner's analysis in the last 5 lines of page 3 of the Third Office

Action (see also last 2 lines on page 3 and first 3 lines on page 4 of the Examiner's Answer), which relies upon Suzuki to teach "a filter plug coupled to said *proxy server* ... messages flowing through the *proxy server*."

In responding to arguments found on page 6, lines 3-8 of the Second Appeal Brief, the Examiner asserted the following on page 9 of the Examiner's Answer:

The Examiner is unclear as to the Appellants comment "the Examiner has failed to provide a claim construction for the claim language at issue" and while not finding this argument persuasive, discusses the argument in detail below:

As best understood, the Examiner has included a chart below which better discloses the portions of the references which have been relied upon within the rejection on appeal in efforts to further "provide a claim construction for the claim language at issue", (emphasis in original)

The difficulties faced by Appellants in addressing the Examiner's analysis is best exemplified by the above-reproduced passages and the table provided by the Examiner on pages 9 and 10 of the Examiner's Answer.

As evident from these passages and the table, the Examiner appears to be confused as to the difference between interpreting the language of a claim (i.e., claim construction) and identifying, within, the applied prior art teachings that allegedly disclose the claimed limitations. "Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art."² Although purporting to be a claim construction, the table provided by the Examiner is the second step and not the first.

² Medichem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

Appellants further note that the table provided by the Examiner could be considered an attempt to meet the requirements set forth in M.P.E.P. § 1207.02. However, this table fails to compare the claim "feature by feature" to the prior art. Instead, the Examiner again relies upon broad brush strokes as to both the claim language being analyzed and the teachings being cited.

The Examiner's table also raises an issue that Appellants previously alluded to above. Specifically, in one instance, the Examiner is asserting that Suzuki does not teach the claimed "proxy server disposed in said wireless service provider network" (see last row of table on page 9) while the Examiner is relying upon Suzuki to teach other limitations associated with the proxy server (see first row of table on page 10). The Examiner's analysis is unclear whether or not the Examiner is asserting that Suzuki teaches a proxy server meeting all of the limitations associated with the proxy server (with the exception of being disposed in a wireless service provider network), or if the Examiner is relying upon the relay server of Suzuki to teach all of the limitations associated with the claimed proxy server.

Moreover, depending upon what the Examiner is relying upon Suzuki to teach, the Examiner's obviousness analysis will be different. For example, in one instance, the Examiner must establish the obviousness of adding another feature (i.e., the proxy server), yet in the other instance, the Examiner needs to establish the obviousness of replacing one feature with another feature (i.e., replacing the relay server with the proxy server). Thus, Appellants respectfully submit that the Examiner has failed to clearly establish how the Examiner is relying upon the applied prior art.

In responding to arguments found on page 6, lines 10-20 of the Second Appeal Brief, the Examiner asserted the following on page 11 of the Examiner's Answer:

The Examiner notes that Suzuki shows plug-in software used to route messages; this plug-in software is affiliated or associated with the filtering of messages which are transacted within the system. Furthermore, the instant application, at Claim 1 is drawn to a filter plug-in used to intercept and route messages, as shown by Suzuki. Any additional matters as mentioned here by Appellant are not taught in the claim language of the instant application.

This passage by the Examiner is non-responsive to Appellant's arguments. Instead, the Examiner has merely repeated the Examiner's prior assertions that Suzuki teaches the claimed limitations at issue. Thus, despite Appellants explaining why the teachings within Suzuki replied by the Examiner do not teach the claimed limitations, the Examiner did not counter these explanations or explain why Appellants' analysis was incorrect. Instead, the Examiner simply ignored this analysis. As an aside, Appellants note that this is one portion of the analysis where a claim construction, by the Examiner, should have been made so as to clarify the Examiner's analysis.

In responding to the arguments found on page 7, lines 1-6 of the Second Appeal Brief, the Examiner asserted the following on page 11 of the Examiner's Answer:

The Examiner notes that Suzuki discloses a relay server, relaying method and payment system. Suzuki, at least at the Abstract shows that the system and method as taught is directed towards a mobile server environment at "portable telephone" and a corresponding subscriber at "user". Furthermore, the Examiner requests that Appellant's look to the Figures within Suzuki as well as the chart included above for any additional specific direction in regards these claim limitations.

Despite the above-reproduced passage, the Examiner has still failed to factually establish that Suzuki teaches the claimed plurality of mobile server wallets have an association with "a corresponding subscriber in a wireless service provider network." The fact that a "user" may correspond to the claimed "subscriber" does not establish that all of the remaining limitations are

also disclosed by Suzuki. The Examiner's statement is entirely silent as to the plurality of mobile server wallets, which have the association with the corresponding subscriber.

As to the Examiner's requesting "Appellant's look to the Figures within Suzuki as well as the chart included above for any additional specific direction in regards these claim limitations," the Examiner, again, appears to be confused as to some of the basic concepts with regard to the Examiner's burden when rejecting a claim. Specifically, the Examiner has the initial burden of factually establishing that the prior art teachings the limitations for which the Examiner is relying upon the prior art to teach, and the Examiner cannot discharge this burden via generalizations as to the teachings of the applied prior art and a request that Appellants 'figure it out for themselves.'

In responding to arguments found on page 7, line 8 though page 8, line 7 of the Second Appeal Brief, the Examiner asserted the following on page 13 of the Examiner's Answer:

The Examiner notes that Steed teaches a server-based electronic wallet system. Steed (Abstract; Page 1, Paragraph 0003-Page 2, Paragraph 0014) discloses a proxy server disposed in the network of its disclosure. The Examiner further requests the Appellant's to see figures 1-2, and 6-7 as well as the Claims of Steed for this teaching.

Regarding the common sense rationale discussed supra: The Examiner notes that, even though, according to the Appellant's, due to Suzuki already teaching the use of an e-wallet, "the Examiner's alleged common sense rationale for the proposed combination would not have rendered the combination obvious since the benefits allegedly resulting from this combination are already obtained through the teachings of Suzuki" are in no way misplaced. Simply because Suzuki already teaches the use of an e-wallet does in no way render the combination non-obvious.

Referring to the first of the two above-reproduced paragraphs, the Examiner has yet again failed to directly respond to Appellants' arguments. Appellants did not argue that Steed does not teach a proxy server, since a proxy server, in isolation, is not being claimed. Instead, Appellants

argued that the Examiner has failed to establish that Steed teaches that the proxy server is disposed within a wireless service provider network, as claimed. The Examiner's "response," however, completely ignores this portion of the argument.

As to the second of the two above-reproduced paragraphs, the Examiner's response can be best characterized as a statement, by the Examiner, of "I disagree" without any explanation. As already argued in the Second Appeal Brief, the Examiner's proposed benefit for the modification (i.e., the proxy server) is (i) not related to the proxy server, but instead, to the use of an electronic wallet and (ii) the proposed benefit is already being provided through the teachings of the primary reference. As such, based upon the Examiner's assertions, the claimed invention would not have been rendered obviousness.

In responding to arguments found on page 8, line 10 through page 9, line 13 of the Second Appeal Brief as to claim 2, the Examiner asserted the following on page 14 of the Examiner's Answer:

The Examiner notes that the use of Official Notice was taken in regards the claim language at hand in conjunction with the teaching of what Suzuki closely discusses as pertinent to the disclosure of the instant application. Furthermore, the Examiner placed reliance not only on paragraph 0030 to teach the claim language in discussion, but also to Figures 3-7 of Suzuki. The Examiner believes that these figures in combination with the mention of the preferable mode discussed in paragraph 0030 to show the claimed language of the instant application at Claim 2.

At the outset, Appellants note that the phrase "Official Notice" is entirely absent from the Examiner's analysis as to claim 1. To be clear, Appellants' arguments were also presented on page 11 of the First Appeal Brief. However, the Examiner did not respond to these argument when the Examiner reopened prosecution in the Third Office Action.

1 Notwithstanding the Examiner's untimely assertion as to "Official Notice," the burden
2 still rests with the Examiner to establish factual evidence of the Examiner's assertions both as to
3 the claimed limitations and also as to the obviousness of modifying the applied prior art to
4 include these teachings. Simply asserting that the limitations are "old and well known in the art"
5 does not establish the obviousness of the limitations. Appellants also note that the Examiner
6 ignored Appellants' arguments in the Second Appeal Brief that what the Examiner asserted is
7 "old and well known in the art" is different than that claimed.

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For the reasons set forth in the Second Appeal Brief, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejection under 35 U.S.C. § 103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: September 8, 2008

Respectfully submitted,

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